

REMARKS

In the Office Action mailed May 25, 2005, the Examiner rejected claims 1-3, 5-13 and 15-20 and objected to claims 4, 14 and 18. By way of the foregoing amendments and the markings to show changes, Applicants have amended claim 1, canceled claims 2-4, 15, 18 and 20 and added new claims 21-28. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Information Disclosure Statement

The Office Action suggested non-consideration of copending applications listed in Applicants' IDS and further suggested that these references are not available as prior art since they are not published. Applicants suggest that it may be possible to issue a rejection based upon these applications as 102(e) provisional rejections or provisional double patenting rejections. For the IDS submitted herewith, patent application publications and patens where available and have otherwise listed the remaining previously non-considered applications and request consideration thereof.

The Office Action suggested non-consideration of non-english language documents DE 1958903 and EP 0236291 as lacking an explanation of the relevance of these documents. Applicants resubmit EP 0236291 for consideration with a translated abstract in the aforementioned IDS. Applicants review of DE 1958903 suggests that the Office Action was actually referring to the reference DE 195 858 903. Applicants review further suggests that the disclosure of DE 195 858 903 is unlikely disclose any information relevant to the patentability of the claims of the present application and that the disclosure of DE 195 858 903 is, at best, cumulative of the other references already disclosed for the present application.

The Office Action suggested non-consideration of the document GB 2375328 suggesting that a copy of the document could not be found. Applicants resubmit this document in the aforementioned IDS submitted herewith.

II. Specification

The Office Action objected to the disclosure at page 6, lines 5-16 suggesting that the status of U.S. Patent Applications listed in the present application should be updated. Applicants have amended the specification such that it is now updated.

III. Claim Objections

The Office Action objected to claim 18 as being an improper dependent claim for failing to further limit the subject matter of a previous claim. Claim 18 has been canceled.

IV. Claim Rejections under 35 USC 102 or 103

With the exception of claims 4 and 14, the Office Action Rejected each of the claims of the present application under 35 USC 102 and/or 35 USC 103 in view of several different references. Claims 4 and 14 were indicated as allowable if rewritten in independent format. Applicants thank the examiner for an indication of allowable subject matter.

Applicants have amended claim 1 to be claim 4 rewritten in independent format. Thus, claim 1 and its dependents are presently allowable. Applicants traverse the rejections of claim 11 and its dependents with particularity.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim again the prior art." *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 11 and its dependents

The Office Action rejected claim 11 and its dependents under 35 USC 103 as being unpatentable over Schneider (U.S. Patent Application Publication 2002/0171260) or Czaplicki (U.S. Patent 6,471,285). Previously, however, the Office Action suggests that Schneider and Czaplicki are 35 USC 102(e) references against other claims of the present application. Applicants contend that, insofar as Schneider and Czaplicki only qualify as prior art under 102(e), they are not valid as references in a 103 rejection because the present application, Schneider and Czaplicki are currently and have always been wholly owned by a single entity, the Assignee of the present application, L&L Products.

Regardless of the qualifications of the references cited by the Office Action, Applicants contend that the Office Action fails to establish a prima facie case of obviousness against claim 11 and its dependents.

The Office Action admits that, "Schneider may not require placement of the structure between a passenger compartment and an engine compartment of the automotive vehicle." The Office action also admits that, "Czaplicki may not require placement of the structure between a passenger compartment and an engine compartment of the automotive vehicle." As such, the Office Action has failed to show how the prior art suggests the claimed invention and has therefore failed to establish a prima facie case of obviousness against claim 11 and its dependents. Applicants acknowledge that the Office Action has attempted to suggest that the skilled artisan would , "understand that sound blocking baffles would be useful between the engine and the passenger compartments in automotive vehicles because the engine compartment is a major source of vehicle sound." However, Applicants contend that such an unsupported allegation does not make up for the lack of establishment of a prima facie case of obviousness.

Furthermore, the unsupported allegations of the Office Action ignore the mandate of the CAFC in the case of *In re Lee* suggesting that the specific combination of the claims must be suggested by the prior art. Applicants contend that the Office Action's assertion about sound blocking baffles being useful between the engine and the passenger compartment is a very general and unsupported assertion that ignores the reality that a great number of considerations can be present when choosing a baffle or other structure for a particular location of a vehicle. The Office Action has not clearly shown that the references of record show or suggest the particular structure of claim 11 and its dependents much less that particular structure in a particular location as recited in claims 11 and its

dependents. Applicants contend that none of the references cited in the office action, singly or in combination, disclose or suggest a structure that, as recited in claim 11, includes: 1) a panel formed of a metal; 2) a layer of magnesium and/or aluminum foam; 3) a viscoelastic adhesive that is bonded to the panel and the layer of foam material; and 4) a structural adhesive that is bonded to the panel and the layer of foam material wherein the structural adhesive is a heat expandable material and wherein the structure is located between a passenger compartment and an engine compartment of the automotive vehicle. This is particularly the case where, as in claim 17, "the panel and the layer of foam material are substantially coextensive with each other". Applicants respectfully request that the rejection of claim 11 and it dependents be withdrawn.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 11 and its dependents on a grounds alternative to that already presented since applicants have not amended claim 11 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

V. New Claims

Applicants have added new claims 21-28 and believe that none of the cited references show or suggest the structure of those claims.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

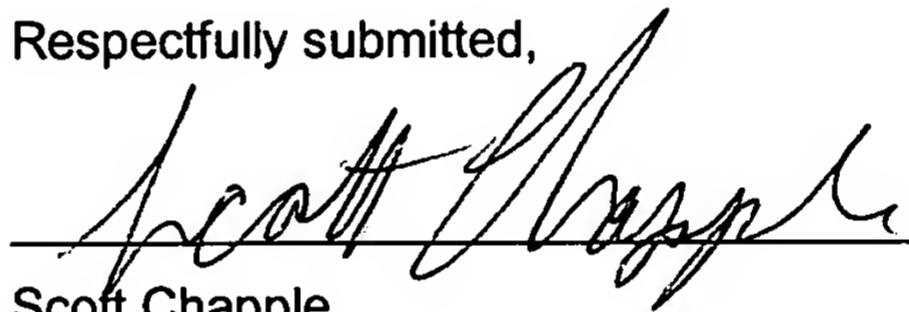
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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Scott Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215